

### REMARKS

This Amendment is submitted in response to the Office Action dated September 22, 2005. In the Office Action, the Patent Office rejected Claims 13-16, 17-19 and 21-23 previously indicated as allowable. In the Office Action, the Patent Office rejected Claims 13-16, 18, 19 and 21-23 under 35 U.S.C. §103(a) as being unpatentable over *Walz* (U.S. Patent No. 5,664,725) in view of *Schwan et al.* (U.S. Patent No. 5,524,934) and further in view of *Petkovsek* (U.S. Patent No. 5,697,648). Still further, the Patent Office rejected Claim 17 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Schwan et al.* and *Petkovsek* and further in view of *Fabel* (U.S. Patent No. 5,836,622). Applicant notes with appreciation that the Patent Office indicated that Claim 20 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

By the present amendment, Applicant submits herewith corrections to FIG. 7 to insert the machine readable article identification number 119 into the article identification number area 118 and to insert the machine readable article identification number 129 into the machine readable document control area 132 of the return postcard 108, respectively, as shown in the Replacement Drawings Sheet and as shown in red in the Annotated Sheet Showing Changes in the attached Appendix. Furthermore, Applicant amended

the specification to identify the machine readable article identification number 119 within the designator section 110 and the machine readable article identification number 129 within the machine readable document control area 132 of the postcard 108. Applicant submits that no new matter is being entered. Approval of the drawing correction and amendment to the specification is requested.

By the present amendment, Applicant amended Claims 13, 17 and 21-23 and added new Claims 27-33. Applicant submits that the amendments to the claims, in view of the remarks that follow, overcome the rejections made by the Patent Office and place the application in condition for allowance. Notice to that effect is respectfully requested.

With respect to the rejection of Claims 13-16, 18, 19, and 21-23 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Schwan et al.* and further in view of *Petkovsek*, Applicant submits that this rejection has been overcome in view of the amendments to Claims 13 and 21-23 and the remarks that follow.

In the Office Action, the Patent Office alleges:

Walz discloses... a mailing assembly and a method of preparing a mailpiece comprising a label... wherein the label (10) includes a single-layered postcard... an integrally formed designator section... a first and second anchor portion... and a backing strip... wherein the backside includes indicia (Col. 4, lines 40-58).

However, *Walz* does not disclose: a designator section indicative of a special service; and a label including shading and printing wherein the shading and printing are a single color.

*Schwan et al.* discloses... a record in the form of a label... having selected portions for forming areas of a plurality of different colors, wherein coatings of colorless color formers and developers are initially combined (upon application of an imaging force) to form colored visible areas (Fig. 3 and 4).

Further, the Patent Office asserts that:

it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Walz's* label to include a label having self contained ink coatings to form a shading and printing of a particular color as set forth by *Schwan et al.*...

Still further, the Patent Office alleges:

However, *Walz* as modified by *Schwan et al.* Does not disclose a printer track strip associated extending outside the exterior sides of the postcard wherein the strip includes a hole and is removably attached to the anchor portion.

*Petkovsek* discloses in Fig. 5, a mailing assembly having a label sheet (11) having a width between a first end (E1) and a second end (E2); wherein the first end has a printer track strip (56) with holes (54) at one end of the assembly (E1) and is removably attached (perforations) to the anchor portion (28); and a second hole at the other end which can be sensed by a printer

Moreover, the Patent Office asserts:

...it would have been obvious to one having ordinary skill in the art as the time the invention was made to modify *Walz's* and *Schwan et al.'s* mailing assembly with a printer track strip extension associated with the label as taught by *Petkovsek* for the purpose of allowing the mailing assembly to be passed through a printer.

As set forth above, independent Claims 13 and 21-23, as amended, define a label having a return postcard and a designator section indicative of one of a plurality of special services. The special service is one of a certified mailing, a return receipt for

merchandise mailing, an insured mailing and a COD mailing. The designator section has shading of a first color and printing of the same color as the first color, and the first color is indicative of the special service.

Further as set forth above, independent Claim 23, as amended, defines the first color is one of green indicative of certified mailing or brown indicative of return receipt for merchandise mailing.

With respect to independent Claims 13 and 21-23, none of *Walz, Schwan et al.* or *Petkovsek*, taken singly or in combination, teaches or suggests a label having a return postcard and a designator section indicative of one of a plurality of special services, as defined by independent Claims 13 and 21-23, as amended. Still further, none of *Walz, Schwan et al.* or *Petkovsek*, taken singly or in combination, teaches or suggests the special service is one of a certified mailing, a return receipt for merchandise mailing, an insured mailing and a COD mailing, as defined by independent Claims 13 and 21-23, as amended. Still further, none of *Walz, Schwan et al.* or *Petkovsek*, taken singly or in combination, teaches or suggests a designator section having shading of a first color and printing of the same color as the first color, wherein the first color is indicative of the special service, as defined by independent Claims 13 and 21-23, as amended.

With respect to independent Claim 23, none of *Walz, Schwan et al.* or *Petkovsek*, taken singly or in combination, teaches or suggests the first color is one of green indicative of certified mailing or brown indicative of return receipt for merchandise mailing, as defined by independent Claim 23, as amended.

On the contrary, *Walz* merely teaches a multi-part mailing form having two superimposed sheets of material wherein detachable areas of the upper sheet are detached and secured to an item to be mailed, and sections of the sheets are separable from one another. Further, *Walz* merely teaches a return receipt with two side portions outside the area that are not adhered together. As admitted by the Patent Office, *Walz* does not disclose a designator section indicative of a special service. Further, *Walz* does not teach a designator section having shading of a first color and printing of the same color as the first color wherein the first color is indicative of the special service.

*Schwan et al.* merely teach a business record, such as a form, label, tag, or the like, in which different selected areas may be color activated. Further, *Schwan et al.* teach a sheet containing surface coatings of selected color formers and color developers which, when subjected to heat or pressure, combine to form different colored areas on the sheet. Still further, *Schwan et al.* merely teach that "the coating may be applied in selected areas which can form blocks of background color, or they may be applied

so as to form images, symbols, stripes, borders, and the like." (See *Schwan et al.*, column 4, lines 57-60.) *Schwan et al.* do not teach a designator section having shading of a first color and printing of the same color as the first color wherein the first color is indicative of the special service.

Moreover, a person of ordinary skill in the art would never have been motivated to combine the teachings of *Walz* with *Schwan et al.* and *Petkovsek* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to

make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Walz, Schwan et al.* and *Petkovsek* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to combine *Walz* with *Schwan et al.* and *Petkovsek* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent Office, the references still lack the novel features and the novel steps positively recited in independent Claims 13 and 21-23, respectively. Namely, none of *Walz, Schwan et al.* or *Petkovsek*, taken singly or in combination, teaches or suggests a label having a return postcard and a designator section indicative of one of a plurality of special services, as defined by independent Claims 13 and 21-23, as amended. Still further, none of *Walz, Schwan et al.* or *Petkovsek*, taken singly or in combination, teaches or suggests the special service is one of a certified mailing, a return receipt for merchandise mailing, an insured mailing and a COD mailing, as defined by independent Claims 13 and 21-23, as amended. Still further, none of *Walz, Schwan et al.* or *Petkovsek*, taken singly or

in combination, teaches or suggests a designator section having shading of a first color and printing of the same color as the first color wherein the first color is indicative of the special service, as defined by independent Claims 13 and 21-23, as amended.

Moreover, none of *Walz*, *Schwan et al.* or *Petkovsek*, taken singly or in combination, teaches or suggests the first color is one of green indicative of certified mailing or brown indicative of return receipt for merchandise mailing, as defined by independent Claim 23, as amended.

Accordingly, the rejection of Claims 13-16, 18, 19, and 21-23 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of dependent Claim 17 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Schwan et al.* and *Petkovsek* and further in view of *Fabel*, Applicant respectfully submits that the rejection has been overcome by the amendment to independent Claim 13 and dependent Claim 17 and for the reasons that follow.

In the Office Action, the Patent Office alleges:

*Fabel* discloses in Col. 10, lines 36-43, wherein the designator section (158) has a machine readable code area.

Further, the Patent Office asserts:

...it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Walz's*, *Schwan et al.'s* and *Petkovsek's* mailing assembly with a designator section having a machine



readable code as taught by Fabel for the purpose of providing additional identifying information.

Claim 17, as amended, requires a special service mailing assembly having an area within each designator section printed with an article identification number.

Contrary to the assertions of the Patent Office, none of *Walz, Schwan et al., Petkovsek* or *Fabel* teaches or suggests that which is required by dependent Claim 17, as amended. The Patent Office acknowledges that "Walz does not disclose wherein the designator section has a machine readable code". *Fabel* merely suggests that "the identifying number, which is placed in [the] left margin of the sender's receipt section... is also printed in block 158, oriented to be readable when upper edge 108 of form 72 is held upward". None of *Walz, Schwan et al., Petkovsek* or *Fabel*, taken singly or in combination, teaches or suggests a special service mailing assembly having an area within each designator section printed with the article identification number, as required by dependent Claim 17, as amended.

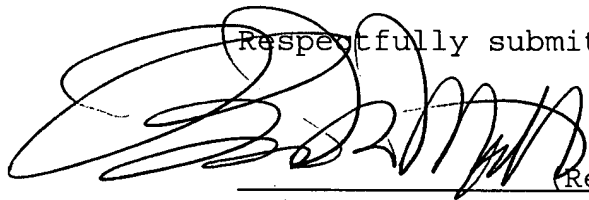
Accordingly, the rejection of dependent Claim 17 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Claims 14-16 and 18-20 depend from independent Claim 13. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent

claims since each sets forth additional structural elements of Applicant's novel assembly.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

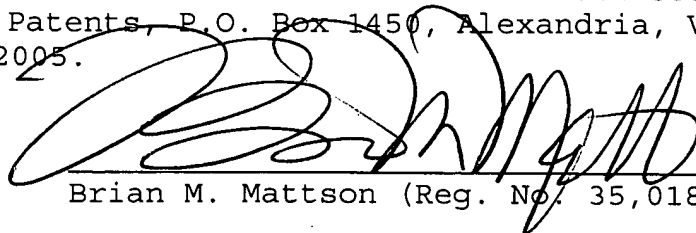


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**CERTIFICATE OF TRANSMISSION**

I hereby certify that this Amendment, Transmittal (in duplicate), Appendix and return-receipt postcard are being transmitted as First Class Mail addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 21, 2005.



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**IN THE DRAWINGS:**

Figure 7 has been corrected as shown in the Replacement Sheet and as shown in red in the Annotated Sheet Showing Changes in the attached Appendix.

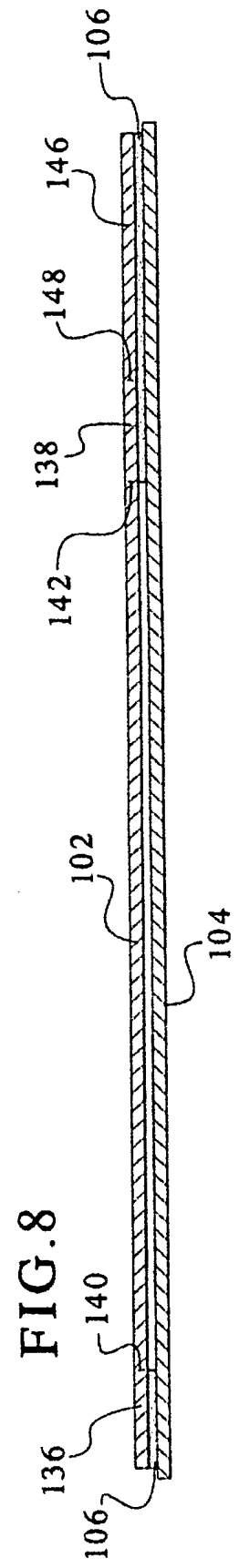
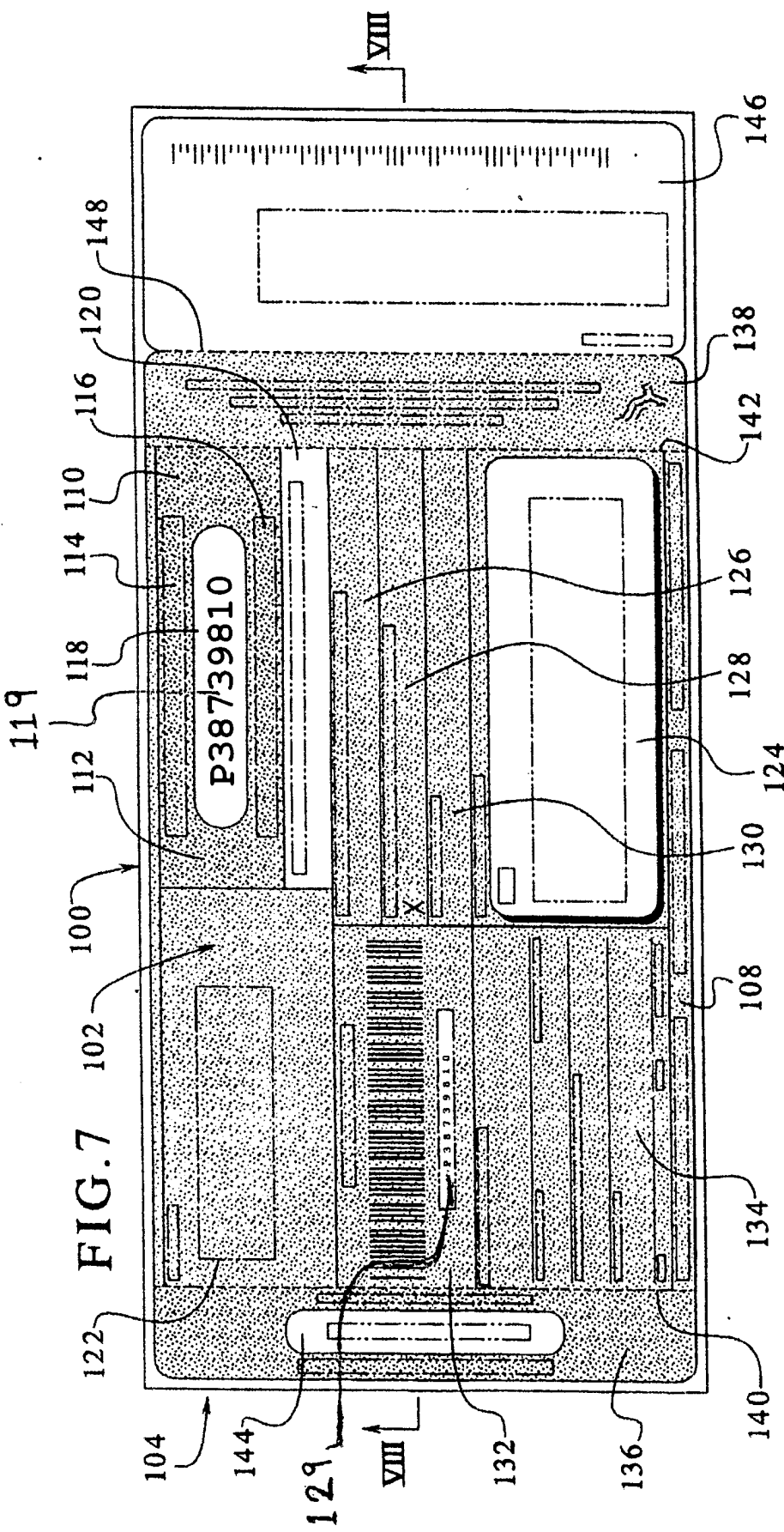


FIG. 8